

Remarks

Claims 1 and 6 have been amended. Support for the instant amendments may be found throughout the embodiments disclosed in the originally filed Specification. No new matter has been added. Accordingly, claims 1-3 and 6-8 are pending.

Reconsideration and allowance of the pending claims based on the following remarks are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

A. Claims 1-3 and 6-7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,819,309 to Kishi ("Kishi") in view of U.S. Patent Application Publication No. 2001/0004190 to Nishi et al. ("Nishi") and U.S. Patent No. 5,581,274 to Tagawa ("Tagawa"). Applicant traverses this rejection for at least the following reasons.

As a preliminary matter, Applicant submits that the Examiner has not established a *prima facie* case of obviousness. In *KSR Int'l Co. v. Teleflex Inc.*¹, the Supreme Court held that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." 550 U.S. at ____, 82 USPQ2d at 1396; *see also id.* ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.") (*citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006)).

The Office Action clearly does not satisfy this requirement. For example, the Office Action provides no rationale as to why one would modify Kishi by Nishi. Rather, the Office Action merely states "**(Need motivation here and below).**" [Office Action, pg. 4 (emphasis added)].

For at least this reason, Applicant submits that the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

¹ 550 U.S. ____, 82 USPQ2d 1385 (2007).

Notwithstanding this deficiency, Applicant submits that neither Kishi, Nishi, nor Tagawa, either alone or in combination, teach or otherwise render obvious the following features of independent claim 1:

an optically transparent substrate;
first pixel electrode formed on said substrate, said first pixel electrodes including light shielding portions, said first pixel electrodes being disposed in a first direction;
second pixel electrodes formed on said substrate, said second pixel electrodes including optically transparent portions, said second pixel electrodes being disposed in a second direction to cross said first pixel electrodes;
common electrodes provided with optically transparent portions corresponding to said first pixel electrodes and light shielding portions corresponding to said second pixel electrodes;

* * *

wherein heights of said first pixel electrodes are different from heights of said second pixel electrodes in a cross-sectional direction of the display device, and at least a part of said first and second switching elements is disposed in a region defined by said substrate and said first pixel electrodes.

For example, the Examiner *concedes* that “Kishi is silent regarding first pixel electrodes including light shielding portions and second pixel electrodes including optically transparent portions.” [Office Action, pg. 4]. However, Applicant submits that not only does Kishi fail to disclose these feature, but that Kishi simply does not require such features, nor would it be predictable to one of ordinary skill in the art. *See, e.g., KSR*, 550 U.S. at ___, 82 USPQ2d at 13 (To establish obviousness, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”).

To be sure, in Kishi, the first and second display media M1 and M2, which are respectively connected to the first and second display electrodes 4 and 5, are located on opposite sides an intermediate substrate 2 and, thus, are apparently only visible from their respective sides of the intermediate substrate 2. [See, Kishi, col. 4, lines 14-34, FIG. 1]. Thus, Applicant submits that one skilled in the art would have no need to modify Kishi to include “common electrodes provided with optically transparent portions corresponding to said first

pixel electrodes and light shielding portions corresponding to said second pixel electrodes,” as the Examiner further alleges.

Moreover, even assuming that Kishi and Tagawa are properly combinable with Kishi (which Applicant does not concede), Applicant submits that the cited portions of Nishi and Tagawa do not overcome the deficiencies of Kishi.

For example, Applicant submits that the Examiner has mischaracterized Nishi. The Examiner alleges that “Nishi et al teaches (Figures 1 and 2) an optically transparent substrate (#101) (Paragraph 26, lines 1-4); first pixel electrodes (43) including light shielding portions (Paragraph 73, lines 1-5); second pixel electrodes (46) including optically transparent portions (Paragraph 82, lines 1-6).” [Office Action, pg. 4]. However, the cited portions of Nishi make no mention or suggestion that the substrate 101 is optically transparent. Indeed, Figure 1 shows light emitted through substrate 110 only, and paragraph [0026] describes substrate 110 – not substrate 101. Further, with regard to the cathode and the anode described in paragraphs [0073] and [0082], these elements drive only one pixel electrode 43. Accordingly, not only is “Nishi ... silent wherein said pixel electrodes are disposed in a first direction, said second pixel electrode are disposed in a second direction to cross said first pixel electrodes,” as the Examiner concedes², but the cited portions of Nishi make no mention or suggestion of “common electrodes provided with optically transparent portions corresponding to said first pixel electrodes and light shielding portions corresponding to said second pixel electrodes,” as claimed.

In addition, Applicant submits that the cited portions of Tagawa do not overcome the deficiencies of Kishi and Nishi, either. For example, the cited portions of Tagawa disclose a display-integrated type tablet device, including X and Y electrodes for coordinate detection. [See, e.g., Tagawa, Abstract; FIG. 1]. However, the cited portions of Tagawa make no mention or suggestion of “common electrodes provided with optically transparent portions corresponding to said first pixel electrodes and light shielding portions corresponding to said second pixel electrodes.”

² Office Action, pg. 4.

Furthermore, Applicant has amended claim 1 to recite that “heights of said first pixel electrodes are different from heights of said second pixel electrodes in a cross-sectional direction of the display device, and at least a part of said first and second switching elements is disposed in a region defined by said substrate and said first pixel electrodes.” Neither the cited portions of Kishi, Nishi, nor Tagawa disclose these features. By contrast, Applicant’s claimed invention advantageously allows an optical emission area in the display device to be largely increased as compared to a conventional display device.

For at least the foregoing reasons, the cited portions of Kishi, Nishi, Tagawa, or a proper combination thereof, do not teach or otherwise render obvious each and every feature of claim 1. Dependent claims 2, 3, and 6-7 depend from independent claim 1 and are therefore, patentable for the same reasons provide above related to claim 1 and for the additional features recited therein. Accordingly, the rejection of claims 1-3 and 6-7 under 35 U.S.C. § 103 (a) based on Kishi in view of Nishi and further in view of Tagawa should be withdrawn and the claims be allowed.

B. Claim 8 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kishi in view of Nishi, in view of Tagawa, as applied to claims 1 and 2, and in further view of U.S. Patent Application Publication No. 2001/0140343 to Hirabayashi et al. (“Hirabayashi”). Applicant traverses this rejection for at least the following reasons.

As discussed above, the cited portions of Kishi, Nishi, and Tagawa do not teach or otherwise render obvious each and every feature of claims 1 or 2.

Further, even assuming that the combination of Kishi, Nishi and Tagawa are properly combinable with Hirabayashi (which Applicant does not concede), Applicant submits that the cited portions of Hirabayashi do not overcome the deficiencies of Kishi, Nishi and Tagawa noted above. For example, the cited portions of Hirabayashi make no mention or suggestion of “common electrodes provided with optically transparent portions corresponding to said first pixel electrodes and light shielding portions corresponding to said second pixel electrodes.”

For at least the foregoing reasons, the cited portions of Kishi, Nishi, Tagawa, Hirabayashi or a proper combination thereof do not teach or otherwise render obvious each

and every feature of claims 1 or 2. Dependent claim 8 depends from claims 1 or 2 and is, therefore, patentable for the same reasons provide above related to claims 1 or 2 and for the additional features recited therein. Accordingly, the rejection of claim 8 under 35 U.S.C. § 103(a) based on Kishi in view of Nishi and further in view of Tagawa, as applied to claims 1 and 2, and further in view of Hirabayashi should be withdrawn and the claim be allowed.

Conclusion

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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